



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,277	07/09/2001	Osamu Nagata	7217/64520	7556

7590 01/17/2006
COOPER & DUNHAM LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
----------	--------------

2656

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,277

Applicant(s)

NAGATA ET AL.

Examiner

Aristotelis M. Psitos

Art Unit

2656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/14/05 & 11/28/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2656

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/05 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As now claimed in claim 1 ^{in the} penultimate and ultimate line:

"a second special code for partitioning each of the respective code names." *is recited.*

However, no support for such is readily seen to exist in the specification as originally filed.

The "/" (which the examiner interprets as the second special code) as disclosed and previously presented – see discussion with respect to the present application commencing at paragraph 15 (so numbered in the USPGPUB # 2002/0041540 A1) which refers to these codes (note --- second special codes --- the examiner interprets such as supported under 37 CFR 1.75 (d) (1)) as being present but only as disclosed with respect to the program names.

Further elaboration with respect to such is respectfully required.

Art Unit: 2656

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1 is rejected under 35 U.S.C. 101 because:

Applicants' attention is drawn to the newly available "interim guidelines" with respect to 101/statutory subject matter available at "www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf".

The following claim analysis is made:

Claim 1:

A recording medium
comprising a program area for recording
a plurality of programs, the programs
are managed into a plurality of groups and
recorded in this form,
the recording medium comprising:

first management information
for managing respective program
names corresponding to the programs
and
second management information
comprising a first special code
for partitioning range information of
program numbers and group names forming

Analysis:

product
arbitrary designation
& desired use
not clear how they are
"managed" by the record medium

abstract idea/information
desired result – not clear how
managed by the record medium

abstract idea/ information/
no special code defined in claim
& desired result -
function of a partition

Art Unit: 2656

the plurality of programs

and

a second special code for partitioning

not clearly supported in the

each of the respective code names.

Specification.

In the above analysis, applicants' attention is drawn to the above interim guidelines starting at page 12, and particularly focusing upon pages 14-17, page 22 and finally at 56-57 thereof.

The examiner has interpreted the above claims as being drawn to

- a) either an abstract idea – information, or alternatively
- b) a signal and hence fails to fall within any categories of invention.

Nevertheless, the following positions are further taken.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4/1 & 3/1 of U.S. Patent No. 6,580,679 in view of *Matsumoto et al* (6,462,263).

The following analysis is made:

Art Unit: 2656

Pending Claim 1 .

6580679

A recording medium

claim 1 lines 1-3

comprising a program area for recording

inherently present

a plurality of programs, the programs

are managed into a plurality of groups and

recorded in this form,

the recording medium comprising:

first management information

claim 1 lines 4-8

for managing respective program

names corresponding to the programs

and

second management information

claim 1.lines 9-11, claim

comprising a first special code

4 – see further analysis below

for partitioning range information of

program numbers and group names forming

the plurality of programs

and

a second special code for partitioning

each of the respective code names.

The above claims are obvious because although the partitioning ability provided by the claimed separating information is not found in the above patent, such is taught by the Matsumoto et al reference, see the discussion with respect to the delimiters at col. 3 lines 5-9. The examiner interprets these as teaching a plurality of delimiting codes, hence meeting both the claimed first and second "special code" for partitioning.

Art Unit: 2656

It would have been obvious to modify the base system of the above noted patent (claims 4/1 & 3/1) with the above teaching from Matsumoto, motivation is to permit easily recognizable data fields, and hence reduce confusion and processing time.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 is rejected under 35 U.S.C. 103(a) as obvious over Utsumi further considered with and Matsumoto et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The following analysis is made.

Utsumi/6,631,100

Claim 1:

A recording medium

see abstract

Art Unit: 2656

comprising a program area for recording area inherently present,
a plurality of programs, the programs area other than the toc
are managed into a plurality of groups and
recorded in this form,
the recording medium comprising:

first management information for table of contents
managing respective program names and the link information
corresponding to the programs recorded on
the program area; and

second management information comprising program names present
a first special code for partitioning range see secondary reference and
information of program numbers and group further analysis below
names forming the plurality of programs
and
a second special code for partitioning
each of the respective code names.

In the above analysis, the examiner interprets that the primary reference/base reference to Utsumi lacks the specific mentioning of information/ special codes for "partitioning" as recited in the above claim.

Nevertheless, as further taught in this environment by Matsumoto, the use/ability of having a plurality of special codes used for partitioning all manners of information is found. See the above description of the "delimiting" ability in Matsumoto et al starting at col. 1, lines 15-39 further describing figure 1 and col 3 lines 5-9. The examiner interprets the Matsumoto et al reference for teaching the ability of having appropriate delimiters (special codes) for designating separate fields of attribute information, i.e., names, artist, music, tracks, etc. – see additionally col. 1 line 48 to col. 2 line 2.

Art Unit: 2656

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al further considered with Ando.

The analysis below is made:

Pending claim 1

A recording medium
comprising a program area for recording
a plurality of programs, the programs
are managed into a plurality of groups and
recorded in this form,
the recording medium comprising:

first management information for
managing respective program names
corresponding to the programs recorded on
the program area; and

second management information comprising
a first special code for partitioning range

information of program numbers and group
names forming the plurality of programs
and

a second special code for partitioning
each of the respective code names.

see abstract

area inherently present,
area other than the toc

searching ability of system,
see col. 1 lines 15-39

see description of fig. 1,
col. 3 lines 5-9,
see secondary reference and
further analysis below

Art Unit: 2656

In the above analysis, the Matsumoto et al reference discloses a record medium having the ability of partitioning by the use of delimiters, various information attributes, names, artist, music, tracks, etc. – see col. 1 line 48 to col. 2 line 2.

Ando further teach with respect to figure 12a, an element 450 which identifies the size/range of each partition.

Hence the ability of using a special code/delimiter for partitioning range information and group names is considered to be an obvious modification and met by the above combined references, motivation is to appropriate delimit/designate/identify various desired attributes of information such as data range (length of a file), as well as any secondary attribute information such as “group” names, etc.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thursday 8 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2656



AMP